

REMARKS

Upon entry of the present amendment, claims 1, 5, 6, 8, 10-17 and 19-26 will have been amended to clarify the recitations of Applicants' invention.

In view of the hereincontained amendments and remarks, Applicants respectfully request reconsideration and withdrawal of each of the outstanding rejections set forth in the above-mentioned Official Action together with an indication of the allowability of all the claims pending in the present application, in due course. Such action is respectfully requested and is now believed to be appropriate and proper.

In the outstanding Official Action, the Examiner rejected claims 19-26 under 35 U.S.C. § 101. The Examiner asserted that the claimed invention is directed to nonstatutory subject matter and particularly noted that claims 23-26 define a signal. The Examiner asserted that a carrier wave is not a statutory class of invention and thus does not comply with 35 U.S.C. § 101. In particular, the Examiner asserted that a signal is not statutory because it is a form of energy and the absence of any physical structure or tangible material that does not fall within any of the four statutory classes of 35 U.S.C. § 101.

The Examiner also rejected claims 19-22 which the Examiner admitted recite a computer readable medium. Although computer readable medium is clearly patentable, the Examiner asserted that, in view of claims 23-26, claims 19-22 are also considered nonstatutory.

By the present response, and without acquiescing in the propriety of the Examiner's rejection of claims 23-26, Applicants have amended claims 23-26 to be in full compliance with 35 U.S.C. § 101 as well as the U.S. Patent and Trademark Office "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility". In particular, claims 23-26 have been amended to recite a computer readable recording medium.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection of claim 23-26.

Regarding claims 19-22, which, as noted above, recite a computer readable medium, it is respectfully submitted that these claims are and have been statutory and in full compliance with the above-noted USPTO Interim Guidelines. Accordingly, Applicants traverse the above rejection.

It is not clear why the Examiner has rejected these claims as being nonstatutory when they recite a “computer readable medium”, merely because claims 23-26 previously recited a “carrier wave”. It is not clear how an asserted deficiency or the nonstatutory nature of one independent claim can render nonstatutory another independent claim.

Nevertheless, Applicants have, as noted above, amended claims 23-26 to define statutory subject matter and accordingly for this additional reason, claims 19-22 should be not subject to any rejection under 35 U.S.C. § 101. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of all of claims 19-26 under 35 U.S.C. § 101.

Claims 1-6, 8-10, 13, 14, 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over WAESTERLID (WO 01/65807) in view of EIDEN et al. (U.S. Published Patent Application No. 2002/0168992) and further in view of KAWAGUCHI et al. (U.S. Published Patent Application No. 2002/0037736). Claim 7 was rejected under 35 U.S.C. § 103 as being unpatentable over the combination of WAESTERLID and EIDEN et al. in view of KAWAGUCHI et al. and further in view of YAGER et al. (U.S. Published Patent Application No. 2003/0070070). Claims 11, 12, 15 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over WAESTERLID in view of KAWAGUCHI et al.

Initially, Applicants note with appreciation the Examiner's apparent agreement that claims 19-26 define allowable subject matter by his not asserting any prior art rejection thereagainst.

Using Applicants' pending claim 1 as a nonlimiting example, Applicants' invention relates to a mail exchange system which includes a plurality of terminal devices connected to one another via a communications network, each terminal device having a member information storage that stores member information of members who belong to a group that exchange mail via the communications network, the plurality of terminal devices comprising a specific member terminal, an existing terminal and a newly joined member terminal.

According to the present invention, as recited in claim 1, the specific member terminal includes a participation mail receiver that receives participation mail, including member information of a member who newly joins the group from the newly joining member terminal via the communication network, a first member information adder that extracts the member information included in the participation mail received by the participation mail receiver and stores the extracted member information in the member information storage, and a new member information mail transmitter that transmits a new member mail, including the member information of the newly joining member, through the existing member terminal according to information stored in the member information storage, via the communications network.

The existing member terminal includes a new member information mail receiver that receives the new member mail, a second member information adder that extracts the member information included in the received new member mail and stores the extracted member information in a member list in the member information storage and a self-information mail

transmitter that transmits an existing member mail, including self-member information to the newly joining member terminal via the communications network.

The newly joining member terminal includes a new participation mail transmitter that transmits the new member mail, including self-member information of the newly joining member, to the specific member terminal via the communications network, an existing member information mail receiver that receives existing member mail from a plurality of existing mail members and a member information generator that generates entries in a member list stored in a member information storage by extracting self-member information from the received existing member mail from the plurality of existing member terminals other than the specific member terminal.

Further, group information indicating the group exchanging the mail is added to the mail to be exchanged among said terminal devices of the members belonging to the group, and the group information includes user information of the terminal device of a member who forms the group and a time when said group is formed.

By the present response, Applicants have amended each of the independent claims in the present application to define “group information indicating the group exchanging the mail is added to the mail to be exchanged among said terminal devices of the members belonging to the group, and the group information includes user information of the terminal device of a member who forms the group and a time when said group is formed”. It is respectfully submitted that in the various respective claimed combinations, the above-noted feature is not taught, disclosed nor rendered obvious by any proper combination of the references relied upon by the Examiner.

In addressing the rejection of claim 6, which previously contained portions of the above-noted feature, which have now been incorporated into each of the independent claims, the Examiner noted that the invitation to join an affinity group may be time limited. The Examiner further asserted that the time period may remain open for a predetermined time period that is set by default or for a time period that is specified by the group administrator in the membership request message. The Examiner asserted that this feature of the primary WAESTERLID reference reads on the claimed “wherein the group information includes user information of the terminal device of a member who forms the group in a time when said group is formed”. In support of this assertion, the Examiner relied on page 12, line 28, through page 13, page 7, of WAESTERLID.

Applicants respectfully traverse and submit that neither the above-noted portion of WAESTERLID nor any other portion of WAESTERLID, nor even any portion of the other references of record in the present application teach, disclose nor render obvious the above-noted group information as now defined in each of the above-noted independent claims.

In particular, the above-quoted section of the WAESTERLID reference deals with invitations to join an affinity group. In particular, WAESTERLID disclose that such invitation to join may be time limited. However, this does not in any way relate to a “time when the group is formed”. There is a significant and substantial difference between when a group is formed and a time period during which a member may join a group. Applicants’ claim recites that the group information includes user information and a “time when the group is formed”. WAESTERLID clearly does not disclose this feature, in the claimed combinations.

Further, and independently of the above, according to the recitations of Applicants’ claims, the group information includes user information of the terminal device of a member. On

the other hand, and as shown in Appendix A of WAESTERLID, the membership request message contains data regarding each member of the affinity group, but not user information of the terminal device of a member. This can clearly be seen with respect to the message format for the membership request message illustrated in Appendix A of WAESTERLID.

Because of each of the above two shortcomings and deficiencies of the WAESTERLID disclosure, it is respectfully submitted that the group information as recited in the combinations of each of Applicants' claims is not taught, disclosed nor rendered obvious therein. Nor do any of the other secondary references relied upon by the Examiner supply this clear deficiency of the primary WAESTERLID reference.

As a result of the above-noted claimed feature of each of the independent claims, the group information can uniquely identify and specify each group, even if the formation of group information is not centrally generated by or in a specific device such as a server. Accordingly, if a user at the same terminal device forms multiple groups or if multiple users of different terminal devices form different groups, each of the groups can be uniquely identified and distinguished from each other by the unique group information defined herein. In other words, because the same user cannot form multiple groups (i.e., fellowships) at exactly the same time, the group ID, which includes user information and a time when the group was formed, uniquely identifies and specifies each group. This information can be generated without involving or passing through the server apparatus. The above-noted feature and advantage of the present invention, as defined in Applicants' independent claims is explicitly disclosed in Applicants' original disclosure, including, *inter alia*, page 12, lines 5-12, and page 24, lines 18-24.

Accordingly, in view of the above arguments and remarks, Applicants respectfully request reconsideration of each of the outstanding rejections asserted against Applicants' claims

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1-26 pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

### SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have amended each of the independent claims to more clearly define the features of the present invention. Applicants have additionally amended claims 23-26 to ensure that these claims define statutory subject matter.

Applicants have discussed the disclosure of the references relied upon by the Examiner and have pointed out the deficiencies thereof. Additionally, Applicants have discussed the recitations of Applicants' claims and have pointed out the shortcomings of the cited reference with respect to the combinations of features. Applicants have also traversed the Examiner's rejection of the recording media claims as being nonstatutory under 35 U.S.C. § 101. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully request an indication to such effect, in due course.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.



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Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,  
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